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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,954	01/03/2001	Fumitaka Ito	PC9978A	3126

7590

02/03/2003

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EXAMINER

KIFLE, BRUCK

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 02/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,954

Applicant(s)

Ito et al.

Examiner

Bruck Kifle, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 28, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's did not submit anything but refer to the amendments filed June 5, 2002. That particular amendment was considered and a final rejection was issued. The examiner has used his discretion in not making this action final to give Applicants an opportunity to respond.

Claim Rejections - 35 USC § 112

Claim 9 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not known which disorder or condition can be effected or facilitated by activating ORL1-receptor and which disorder or condition is not. One skilled in the art cannot say for sure whether a given disorder or condition can be effected or facilitated by activating ORL1-receptor or not.

Claims 9 and 10 also remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling as a method of treating pain, does not reasonably provide enablement for treating all of the other disorders or conditions recited in the claims. The basis of

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this rejection is the same as given in the previous office action and is incorporated herein fully by reference. Applicants argue that no sufficient reason has been given. However, several points were raised in the previous office action to none of which Applicants have responded.

Applicants' reliance on the Brana decision is erroneous since the facts were different in more than one respect from the instant case. Compounds on appeal were of a much narrower scope and there were no method claims. Said compounds were similar in structure to compounds displaying in vivo anti-tumor activity based on art-recognized in vivo tests and also tested favorably in an in vivo test. Thus contrary to Brana it is not evident that at the time of applicants' effective filing that the instant compounds having such a diversity of substituents and a diverse "core" could be used for treating any and all cancers, hyperproliferative cellular disease or diseases associated with angiogenesis.

Double Patenting

Claims 1-6 and 9-11 are again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,172,067. Although the conflicting claims are not identical, they are not patentably distinct from each other because the two sets of claims overlap substantially. Applicants are required to maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.


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Claims 1-6 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 6,172,067). The reference teaches a generic group of benzimidazole derivatives which embraces applicants' claimed compounds (See cols 1-3, compounds of formula (I) and definitions for R, A and Y). The basis of this rejection is the same as given in the previous office action and is incorporated herein fully by reference. Applicants argue that the instant claims are not obvious. However, the claims are indeed obvious over Ito et al. as explained in the previous office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

January 30, 2003


Bruck Kifle
Primary Examiner
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